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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

AVELLINO, JOSEPH E


ART UNIT

PAPER NUMBER

2143

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/003,818	Applicant(s) WILEY ET AL.	
	Examiner Joseph E. Avellino 	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/13/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are presented for examination; claims 1, 14, and 20 independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose to one of ordinary skill in the art an establishment of a direct connection to a receiving device. If this is an oversight by the Office, Applicant is invited to point out as to where this feature can be found in the disclosure.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. (USPN 6,704,118) (hereinafter Hull) in view of Tsuei (USPN 6,654,779).

6. Referring to independent claim 1, Hull discloses a method for providing a remote document history repository (e.g. document image repository), comprising:

establishing a direct connection (the Office takes the term "direct connection" to be construed as "a point-to-point connection" to a receiving device (an inherent feature, since the email is transmitted from the sending device to an email server, it is inherent that the device establishes a communication to the receiving device) (col. 8, lines 28-30);

sending a document (i.e. e-mail) from a multifunction device (i.e. client device 102) to a recipient (i.e. receiving mail box on receiving email server) at the receiving device via the direct connection (i.e. emails sent and received by a user) (col. 8, lines 28-35);

recording delivery data for said sent document in said remote document history repository when said document is sent from said multifunction device (i.e. sends a copy of every message sent...to the document management workstation 108) col. 8, lines 51-60).

Hull does not specifically state that the delivery data can be used to automatically resend the document to the recipient from the history repository independent of the multifunction device if the document is not received by the recipient. In analogous art, Tsuei discloses another method of email transmission wherein the delivery data can be used to automatically resend the document to the recipient from the history repository independent of the multifunction device if the document is not received by the recipient

(i.e. if the recipient's email address has changed resulting in a bounce *error*, the sending ISP queries the EAMS 330 to determine the new email address, and then the sender ISP 120 automatically forwards the message to the intended recipient) (col. 7, lines 30-50). It would have been obvious to one of ordinary skill in the art to combine the teaching of Tsuei with Hull in order to allow the document management workstation 108 the abilities of the sender ISP of Tsuei in order to automatically resend documents which have been sent, removing the situation described in Tsuei of a user searching the internet to find a new e-mail address of a user, resulting a delay in delivery of the email (col. 2, lines 48-50), thereby providing a system which automatically finds a user's new email address when an old email address becomes invalid as supported by Tsuei (col. 2, lines 53-65).

7. Referring to claim 2, Hull discloses the remote document history is used to track document flow (i.e. operating a document image database) (col. 9, lines 30-40).

8. Referring to claim 3, Hull discloses the multifunction device is a multifunction peripheral (the Office construes the term "multifunction peripheral" to be "any device which can perform at least two functions) (i.e. client computer 102) (col. 8, lines 28-30).

9. Referring to claim 4, Hull discloses updating said remote document history repository to indicate receipt of said sent document (i.e. saving destination information) (col. 10, lines 35-40).

10. Referring to claim 5, Hull discloses copying said document to said remote document history repository (col. 8, lines 55-60).

11. Referring to claim 6, Tsuei discloses resending said document by sending said copied document from said remote document history repository (i.e. the document is sent from the sending ISP, not the sending client, inherently indicating that the document was somehow copied in the ISP, since the document is automatically forwarded without the user's intervention) (col. 7, lines 40-50). It would have been obvious to one of ordinary skill in the art to combine the teaching of Tsuei with Hull in order to allow the document management workstation 108 the abilities of the sender ISP of Tsuei in order to automatically resend documents which have been sent, removing the situation described in Tsuei of a user searching the internet to find a new e-mail address of a user, resulting a delay in delivery of the email (col. 2, lines 48-50), thereby providing a system which automatically finds a user's new email address when an old email address becomes invalid as supported by Tsuei (col. 2, lines 53-65).

12. Referring to claim 7, Tsuei discloses redirecting the document by sending (i.e. forwarding) the copied document from the repository (i.e. sender ISP) to another recipient (i.e. another email address) (col. 7, lines 30-45).

13. Referring to claim 8, Hall discloses copying said document to a network site (e.g. document management workstation, or email system when the document is transmitted) (col. 8, lines 28-60; col. 10, lines 20-30).

14. Referring to claim 9, Hall discloses notifying an intended recipient of said document that said copied document is available from said network site (i.e. an inherent feature of an email server is that when the user checks for messages, the email server notifies the user that the message is present, otherwise the message would never be received by the recipient) (col. 8, lines 20-30).

15. Referring to claim 10, Tsuei discloses notifying a sender of said document that said document is undeliverable (i.e. transmitting a "message could not be delivered" message) (col. 7, lines 40-55).

16. Referring to claim 11, Hall in view of Tsuei disclose the invention substantively as described in claim 1. Hall in view of Tsuei do not specifically disclose monitoring the receipt of the document and resending the document after a predetermined time based on the delivery data in the history repository, however it is well known that data in a computer network is commonly resent if an acknowledgement is not transmitted back to the server (i.e. TCP/IP and sequence numbers for packets, fax machines will retransmit data if no response is received). By this rationale, "Official Notice" is taken that both the concept and advantages of providing for monitoring receipt of an email, and if an email

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is not acknowledged in a predetermined amount of time, resending the email. It would have been obvious to one of ordinary skill in the art to modify the teaching of Tsuei and Hall since email requires low error rates, thereby using a protocol which insures error correction such as TCP/IP which automatically retransmits unacknowledged packets, thereby providing a low error rate protocol which ensures a proper transmission.

17. Referring to claim 12, Hall discloses recording said delivery data is transparent to the user of the multifunction device (i.e. "without further user intervention") (e.g. abstract).

18. Referring to claim 13, Hall discloses converting a paper document to an electronic document at a multifunction device (e.g. copier, fax machine, etc.) for sending therefrom (i.e. the document is sent to the document manager, the recipient) (e.g. abstract).

19. Claims 14-28 are rejected for similar reasons as stated above.

Response to Arguments

20. Applicant's arguments dated December 13, 2005 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

21. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEA
January 20, 2006



JEFFREY PWU
PRIMARY EXAMINER